

Docket No.: 4481-021



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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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MAY 21 2003  
TC 1700

In re Application of :  
Manfred BERNDT :  
Serial No. 09/598,968 : Group Art Unit: 1743  
Filed: June 22, 2000 : Examiner: J. Brown

For: "DEVICE TO OPERATE A LABORATORY MICROCHIP"

FURTHER RESPONSE TO NOVEMBER 26, 2002 OFFICE ACTION

Assistant Commissioner for Patents  
Washington, D. C. 20231

*OK to ENTER*  
*ms*  
*5/27/03*

Sir:

Applicant submits herewith a certified translation of the German Application relied on for priority. The certified translation removes the rejection of claims 1-12 and 14 under 35 USC 102(f).

In response to the comment in the April 3, 2003 Advisory Action that element 85 on the drawings is not identified as a microchip in the specification, it is applicant's position that one of ordinary skill would understand from the drawing and specification that element 85 is a microchip. Reference numeral 82 on page 15, line 2 of the application refers to a microchip illustrated on Fig. 5b. It is evident that microchip 82 of Fig. 5b and the structure identified by reference numeral 85 on

Fig. 4d refer to the same structure. Fig. 5b and the description thereof refer to pins 83 on intermediate carrier 81 which is obviously carried by element 78. Figs. 5a and 5B indicate the relationship of element 78 when it is spaced from and closed on microchip 82. Fig. 4d indicates the same relationship between microchip 85 and pins on intermediate carrier 73, when the carrier is open. Further page 14, lines 14-16 says ``when assembly 78 is closed, assembly 78 contacts the microchip-holding first assembly 79 and automatically creates the necessary line connections for operating the microchip.'' The only structure on assembly 79 of Fig. 4d that can be constructed as a microchip which would be provided to such line connections is the structure bearing reference number 85.

The similarity of the structure bearing reference numeral 85 and the structure identified in Fig. 2 and described on page 9, line 32 - page 11, line 12 (microchip 20), in Fig. 3 and on page 11, line 18 - page 12, line 7 (microchip 52), and in Fig. 5b and described on page 15, line 2, makes it evident to one of ordinary skill in the art that the structure bearing reference numeral 85 is a microchip. As a matter of fact, the undersigned attorney of applicant, who certainly cannot be considered as coming close to being one of ordinary skill in the art, immediately realized that the structure bearing reference numeral 85 was a microchip.

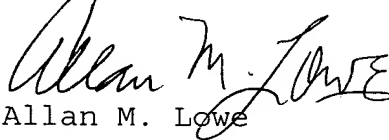
Based on the foregoing, the rationale set forth in the advisory action for the rejection of claims 19-25 under 35 USC 112, paragraph 1 is without merit. Since no art has

been applied against claims 19-25 and the specification  
(including the drawings) enable one of ordinary skill to  
make and use the structure that claims 19-25 define,  
allowance of claims 19-25 is in order.

Issuance of a Notice of Allowance is in order.

Respectfully submitted,

LOWE, HAUPTMAN GILMAN & BERNER, LLP



Allan M. Lowe

Dated: May 16, 2003 Reg. No. 19,641

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